

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAR 13 2000

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TYLER PEPPEL

RECEIVED

Appeal No. 1998-2848
Application 08/398,862¹ NOV 25 2002

ON BRIEF

Technology Center 2100

Before BARRETT, FLEMING, and NASE, Administrative Patent Judges.
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 1-39.

We affirm, but enter new grounds of rejection.

¹ Application for patent filed March 6, 1995, entitled "Electronic Trading Card."

BACKGROUND

The disclosed invention is directed to a system and method for implementing a trading card metaphor in an electronic trading card (ETC). ETCs are segments of computer code that have a data format as shown in Figure 1. ETC products may be of various types, such as clue cards, code cards, sports cards, and character cards (Figure 4). ETCs may be made, traded, used in activities (such as game playing), or may be collected like paper trading cards (specification, pages 8-9; Figure 6).

Claims 1, 16, and 21 are reproduced below.

1. A system for the implementation of a trading card metaphor, comprising:

a disassociated computer program, consisting of a plurality of electronic trading cards (ETCs), each ETC corresponding to a disassociated computer code segment and having an electronic format that supports card scarcity and card authenticity.

16. A method for implementing a trading card metaphor in an electronic trading card (ETC), comprising the steps of:

entering a multiroom virtual environment where each room in said environment requires a specific set of ETCs to complete an ETC collection, each ETC corresponding to a disassociated computer code segment and having an electronic format that supports card scarcity and card authenticity;

finding a missing ETC;

completing said set; and

reward when said set is completed.

21. A method for implementing a trading card metaphor, comprising the steps of:

a dissociating a computer program, consisting of a plurality of electronic trading cards (ETCs), each ETC corresponding to a disassociated computer code segment and having an electronic format that supports card scarcity and card authenticity.

The Examiner relies on the following prior art reference:

Smith et al. (Smith) 5,533,124 July 2, 1996
(filed December 7, 1994)

Claims 1-39 stand rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

Claims 1-39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Smith.

We refer to the Office Action (Paper No. 10) entered May 21, 1997, and the Examiner's Answer (Paper No. 17) (pages referred to as "EA__") for a statement of the Examiner's position and to the replacement Brief (Paper No. 16) (pages referred to as "Br__") filed March 2, 1998, for Appellant's arguments thereagainst.

OPINION

Interpretation of "disassociated"

The claims first require interpretation. "[T]he name of the game is the claim." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). In particular, we define the term "disassociated" which appears in all independent claims.

Appeal No. 1998-2848
Application 08/398,862

The Examiner states (Paper No. 10, page 2):

The claimed invention is directed to data structures representing descriptive material per se. This determination is based on the fact that Applicant has intentionally avoided claiming the mechanism or medium that is interrelated with the data structure; e.g.: "disassociated computer program"; "disassociated computer code segments." See M.P.E.P. 2106.

The Examiner further states (EA5):

The word "disassociated" means: "to disconnection [sic] from association, dissociate," Webster's New International Dictionary, Second Edition, (1939). A computer program is associated with a medium; e.g. a disk or computer memory. Therefore, a disassociated computer program is a program not associated when [sic] a medium.

Thus, the Examiner interprets "disassociated" to mean not associated with a tangible medium.

A "computer program" per se is an abstract entity and does not imply association with a storage medium or memory. A medium must be explicitly recited. Therefore, we do not interpret "disassociated" to necessarily refer to lack of association with a tangible medium, although it could have that meaning also. The term "disassociated" is used in the specification in the sense of "separate," "standing by itself," or "not part of something else," which is consistent with its normal meaning of "detached from association." For example, the specification discusses the opportunity for "multimedia products that allow consumers to browse, create, collect, and exchange disassociated pieces of multimedia data" (emphasis added) (page 4, lines 7-8) as opposed to "large, monolithic collections of data that can only be

Appeal No. 1998-2848
Application 08/398,862

browsed by the consumer" (page 4, lines 9-10). As another example, the specification discusses "disassociated components in the form of ETCs" (page 20, lines 2-3).

We interpret "a disassociated computer program" in claim 1 to be a separate computer program, i.e., a program that is not part of a larger computer program. The "ETC corresponding to a disassociated computer code segment" in all of the independent claims is interpreted to mean that the ETC is a separate computer code segment, i.e., a code segment that is not part of a larger code segment. Because the claims do not recite that the computer program or the computer code segment is stored on a tangible medium, no medium is expressly or impliedly claimed.

35 U.S.C. § 101

The Examiner states (Paper No. 10, page 2):

The claimed invention is directed to data structures representing descriptive material per se. This determination is based on the fact that Applicant has intentionally avoided claiming the mechanism or medium that is interrelated with the data structure; e.g.: "disassociated computer program"; "disassociated computer code segments." See M.P.E.P. 2106.

Section 2106 of the Manual of Patent Examining Procedure (MPEP) reproduces the Patent and Trademark Office Examination Guidelines for Computer-Related Inventions (Guidelines),

Appeal No. 1998-2848
Application 08/398,862

1184 Off. Gaz. Pat. & Trademark Office 87 (March 26, 1996)².

As stated in MPEP § 2106 under heading IV.B.1, "Non-Statutory Subject Matter":

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when encoded on a computer-readable medium. . . . "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. . . . When nonfunctional descriptive material is recorded on some computer-readable medium, it is not structurally and functionally interrelated to the medium but is merely carried by the medium. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. . . .

We refer to the analysis in section IV.B.1(a) in the MPEP and the Guidelines for further analysis. Computer programs and data structures per se are abstractions and do not fall within any of the four statutory categories of patentable subject matter.

Appellant groups claims 1-39 to stand or fall together (Br11). Thus, the rejection would normally be decided on the basis of a single claim. See 37 CFR § 1.192(c)(7) (1997). Although Appellant reproduces the independent claims, this does

² MPEP § 2106 incorporates the footnotes of the Guidelines into the body of the text and changes some wording, such as "non-functional" in the Guidelines to "nonfunctional."

Appeal No. 1998-2848
Application 08/398,862

not constitute an argument as to why the claims are separately patentable. Id. Under the rules, we could consider claims 1-39 to stand or fall together with claim 1, in which case all the claims would be considered nonstatutory because claim 1 is nonstatutory. However, we have decided to address the independent claims separately. The dependent claims will stand or fall with their respective independent claim.

Independent claim 1 and dependent claims 2-14

The "disassociated computer program" in claim 1 is a computer program per se, i.e., a computer program in the abstract and not embodied in any tangible medium. It is considered non-statutory "functional descriptive material" for the reasons discussed in the Guidelines and the MPEP. The "ETC corresponding to a disassociated computer code segment and having an electronic format" is a data structure per se, i.e., a data structure (as shown in Figure 1) in the abstract and not embodied in any tangible medium. It is also considered non-statutory "functional descriptive material" for the reasons discussed in the Guidelines and the MPEP. Claim 1, as a whole, does not recite statutory subject matter. Although claim 1 is directed to a "system" in the preamble, this is not determinative of statutory subject matter. See In re Walter, 618 F.2d 758, 205 USPQ 397 (CCPA 1980) (system claims and method claims held nonstatutory).

Appeal No. 1998-2848
Application 08/398,862

Appellant argues that the § 101 rejection is untimely and puts an undue burden on Appellant (Br12-13). While it is unfortunate that the Examiner did not enter the § 101 rejection until the third Office action, there is nothing that can be done. Examiners are charged with making sure that an "applicant is entitled to a patent under law," 35 U.S.C. § 151. A statutory ground of rejection cannot be dismissed just because it was not entered earlier.

Appellant argues (Br13): "The Examiner's proposition 'that the Applicant has intentionally avoided claiming the mechanism or medium that is interrelated with the data structure' is pure speculation without any factual basis and, moreover, is apt to offend Applicant and his Counsel." The claims define what Appellant regards as his invention. 35 U.S.C. § 112, second paragraph. Since claim 1 does not recite any substrate medium on which the computer program and ETCs are stored, it must be presumed that Appellant intended not to claim the medium.

Appellant quotes claims 1, 15, 16, 19, 21, and 38 and concludes (Br15-16): "Clearly, none of the above claims is directed to data structures representing descriptive material per se. [Paragraph] For example, Claim 1 essentially recites a system comprising a disassociated computer program consisting of electronic trading cards." Appellant makes no effort to address why a computer program and an ETC computer code segments are not

Appeal No. 1998-2848
Application 08/398,862

descriptive material "per se" under the Guidelines and the MPEP, that is, Appellant has not shown how the claims (especially claim 1) recite something physical.

Appellant quotes from the specification and states (Br16):
"The concept of the conventional trading card is well known, and, in doubt, the physical appearance of the electronic trading card would have to be assumed to be similar to that of a conventional trading card." The claims define the invention. It is Appellant's responsibility to claim what he regards as his invention and we assume the claims reflect Appellant's intent. Here there is nothing physical about what is claimed in claim 1 and no physical appearance is recited. Limitations will not be read into the claims from the specification to make the claimed subject matter statutory. Moreover, it is not clear what limitations Appellant would have read in from the specification.

Appellant argues (Br16-17):

From the above it is clear that it is not a data structure per se or a computer program per se (so-called Functional Descriptive Material) which is claimed. See M.P.E.P. 2106 B 1.(a): "Data Structures [sic] not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical 'things' nor statutory processes." The present claims are clearly different and directed to different subject matter than was claimed in Warmerdam, 33 F.3d, 1361, 31 USPQ2d, 1760 [cited in footnote 30 in the Guidelines to the quotation] where a claim to a data structure per se was held nonstatutory. While the invention may be worked using a series of steps to be performed on a computer (e.g. in case of on-line ETCs), the system according to the invention may as well be implemented by using physical trading cards containing the particular ETC format (i.e. ETCs on physical media). But

Appeal No. 1998-2848
Application 08/398,862

even in the former case, the invention does not merely manipulate an abstract idea or solve a purely mathematical problem without any limitation to a practical application. With the present invention, electronic trading cards must be produced or created, distributed or traded, then collected, and offer some kind of reward when a series of ETCs has been completed. Electronic trading cards can be viewed, either on a computer screen or on some other physical media (see order, In re Gary M. Beauregard, et al., Case No. 95-1054, Fed. Cir., 12 May 1995) ("Connector [sic ?] Programs Embodied in a Tangible Medium ...are patentable subject matter under 35 USC § 101...").

Again, the claims define the invention and claim 1 does not recite that the computer program and the ETC computer code segment are embodied in physical media. The claimed computer program and a computer code segment having a certain format (i.e., a data structure) are abstract. The citation of In re Beauregard is inapposite because the claimed subject matter is not embodied in a tangible medium as noted in the quotation.

For the reasons discussed above, Appellant has not persuaded us of error in the rejection of claim 1. The § 101 rejection of claim 1 and its dependent claims 2-14 is sustained.

Independent claims 15, 16, and 19
and dependent claims 17, 18, and 20

Claims 15, 16, and 19 are method claims and, therefore, the analysis applied to claim 1 does not hold. The Examiner apparently recognized this when writing the Examiner's Answer and provided this additional reasoning (EA3-4):

The claimed invention of claims 15, 16, 19, 21 and those dependent therefrom are directed to abstract ideas. Each set of claims describe an ethereal function. If the

Appeal No. 1998-2848
Application 08/398,862

function is not ethereal then it is unknown who (a person) or what (a computer) is performing the function or who or what is being operated on by the function.

Appellant did not file a reply brief to challenge these new reasons by the Examiner. See 37 CFR § 1.193(b) (appellant may file a reply brief addressing new points of arguments). Nevertheless, we do not affirm the rejection pro forma.

"[A] series of steps is a 'process' within § 101 unless it falls within a judicially determined category of nonstatutory subject matter exceptions." In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). The recognized exceptions are for "laws of nature, natural phenomena, and abstract ideas." See In re Alappat, 33 F.3d 1526, 1542, 31 USPQ2d 1545, 1556 (Fed. Cir. 1994) (in banc) (citing Diamond v. Diehr, 450 U.S. 175, 185 (1981)). The key to statutory subject matter is whether the claimed subject matter is directed to a "practical application," which the Federal Circuit has said is "a useful, concrete and tangible result." State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d 1368, 1375, 47 USPQ2d 1596, 1602 (Fed. Cir. 1998). Thus, a "process" no longer requires a physical transformation of something to a different state or thing (although such transformations fall within the so-called "safe harbors" of the Guidelines and MPEP § IV.B.2.(b)(i)).

Claim 15 recites steps of "assembling and personalizing at least one ETCs [sic]," "choosing a format and setting for said

Appeal No. 1998-2848
Application 08/398,862

ETC," followed by several optional steps. These steps are directed to a "useful, concrete and tangible result" of preparing an ETC. We do not agree with the Examiner's conclusion that the steps are "ethereal" in the sense of lacking some physical action. The § 101 rejection of claim 15 is reversed.

Claim 16 recites steps of "entering a multiroom virtual environment where each room in said environment requires a specific set of ETC to complete an ETC collection," "finding a missing ETC," "completing said set," and "reward when said set is completed." These steps are directed to a "useful, concrete and tangible result" of an ETC collecting activity. We do not agree with the Examiner's conclusion that the steps are "ethereal." The § 101 rejection of claim 16 and its dependent claims 17 and 18 is reversed.

Claim 19 recites steps of "solving a puzzle having increasing levels of difficulty using a series of [ETCs]" and "reproducing a personalized certificate of completion when, and only when, each level of said puzzle is solved, said certificate of completion optionally including clues to solve a next level of said puzzle." These steps are directed to a "useful, concrete and tangible result" of playing a puzzle game using ETCs. We do not agree with the Examiner's conclusion that the steps are "ethereal." The § 101 rejection of claim 19 and its dependent claim 20 is reversed.

Appeal No. 1998-2848
Application 08/398,862

NEW GROUND OF REJECTION UNDER 37 CFR § 1.196(b)
Independent claim 21 and dependent claims 22-37

We enter a new ground of rejection under 37 CFR § 1.196(b) as to claim 21 and its dependent claims 22-37 under 35 U.S.C. § 112, second paragraph.

Claim 21 recites the single step of "a dissociating a computer program, consisting of a plurality of electronic trading cards (ETCs), each ETC corresponding to a disassociated computer code segment and having an electronic format that supports card scarcity and card authenticity." In our opinion, the phrase "a dissociating a computer program" is indefinite under 35 U.S.C. § 112, second paragraph. It cannot be determined whether claim 21 intends to recite "dissociating a computer program" or "a dissociating computer program." In any case, it is not known what is meant by either phrase and we find no description of either phrase in the specification.

We reverse the § 101 rejection of claims 21-37. Where the claimed subject matter is indefinite, an evaluation thereof relative to statutory subject matter is inappropriate. Cf. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious--the claim becomes indefinite); In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962) ("[O]ur analysis of the claims leaves us in a quandry as to what is covered by them. We think

Appeal No. 1998-2848
Application 08/398,862

the examiner and the board were wrong in relying on what at best are speculative assumptions as to the meaning of the claims and basing a rejection under 35 U.S.C. § 103 thereon.").

Independent claim 38 and dependent claim 39

System claim 38 recites "said ETC including a display system, a housing, software, a battery, a CPU, and an LCD display." Thus, system claim 38 recites physical structure which has not been addressed by the Examiner. Although claim 38 does not recite that the ETC data structure is contained in a memory (which is missing from the list of structure), the structure included with the ETC is enough to provide statutory subject matter. Accordingly, the § 101 rejection of claims 38 and its dependent claim 39 are reversed.

35 U.S.C. § 102(e)

The rejection stands or falls based on the sufficiency of the Peppel declarations to antedate the Smith patent

The merits of the anticipation rejection over Smith have never been argued during prosecution and are not argued in the Brief. See 37 CFR § 1.192(c)(8)(iii) (1997). (In the rule governing the content of the Argument section of the appeal brief: "For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the

Appeal No. 1998-2848
Application 08/398,862

prior art relied upon in the rejection."). Appellant relies exclusively on the (First) Declaration Under 37 CFR § 1.131 by the inventor Tyler Peppel (part of Paper No. 5) and the Second Declaration Under 37 CFR § 1.131 by Mr. Peppel (Paper No. 8) to antedate the Smith patent. Accordingly, the rejection will be decided based on the sufficiency of the Peppel declarations to swear behind Smith. Cf. In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967) ("This court has uniformly followed the sound rule that an issue raised below which is not argued in this court, even if it has been properly brought here by a reason of appeal, is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them."); In re Wiseman, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (arguments must first be presented to the Board before they can be argued on appeal).

The Peppel declarations do not establish conception of the claimed invention coupled with diligence to the filing date

A prior art patent which does not claim the same patentable invention may be sworn behind under 37 CFR § 1.131 by a showing of facts sufficient to establish a completion of the invention in

Appeal No. 1998-2848
Application 08/398,862

this country before the filing date of the application on which the U.S. patent issued. "The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application."

37 CFR § 1.131(b). The "invention" refers to the subject matter of the claims. The purpose of the Rule 131 showing is to establish broadly possession of the invention. A Rule 131 declarant need not necessarily show possession of the entire invention as later claimed; it is sufficient that he shows possession of enough to make the entire invention obvious to one of ordinary skill in the art. See In re Spiller, 500 F.2d 1170, 1176, 182 USPQ 614, 618-19 (CCPA 1974). Cf. Bosies v. Benedict, 27 F.3d 539, 543, 30 USPQ2d 1862, 1865 (Fed. Cir. 1994) (In interferences: "The question of conception is properly directed to whether there was 'formation [] in the mind of the inventor of a definite and permanent idea of the complete and operative invention . . . [and whether] every limitation of the count [was] known to the inventor at the time of the alleged conception.' Coleman v. Dines, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985) (emphasis added).").

Appeal No. 1998-2848
Application 08/398,862

The Examiner states (Paper No. 10, pages 2-3):

The evidence is insufficient to establish a conception of the invention prior to the effective date of the Smith et al. reference. Conception is the mental part of the inventive act. The Applicant proves conception either by demonstrative evidence or by a complete disclosure to another. In this case, providing a photocopy of a lab notebook page having the word "E-Card" is not demonstrative evidence. Demonstrative evidence is evidence that would enable one skilled in the art to understand what the invention is; e.g.: a flowchart or a block diagram is such evidence in this technological art. Furthermore, the evidence showing communications between an inventor and a third party does not show complete disclosure to another. It is clear that the communication[s] were in regards to a licensing agreement. A reasonable businessman when in a potential arms-length negotiation would not "show all his cards" to his adversary for fear of losing leverage and proprietary rights; therefore, complete disclosure to another was not conveyed at these meetings or communications.

....

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice to [sic, of] the Smith et al. reference to constructive reduction to practice, i.e. the Applicant's filing date. The particular "screen shots" are insufficient to show diligence because the Applicant has not provided evidence to establish the contents of each document and the authenticity of the dates shown next to the document icons.

Thus, the Examiner finds the declarations and evidence insufficient to establish conception and diligence, both of which are necessary to antedate the Smith patent.

Appellant argues that the Peppel declarations provide evidence of conception prior to the effective date of Smith (December 7, 1994) along with evidence of due diligence (Br18).

Appeal No. 1998-2848
Application 08/398,862

The declarations authenticate the evidence, but make no attempt to correlate the evidence with the limitations of the claims.

We agree with the Examiner's conclusion that the evidence is not sufficient to establish conception and diligence, but disagree with the Examiner's expressed reasons. Thus, although we sustain the rejection, we designate this a new ground of rejection because Appellant has not had a fair opportunity to respond. See In re Kronig, 539 F.2d 1300, 1302, 190 USPQ 425, 426 (CCPA 1976) (the "ultimate criterion" of whether a rejection is new is "whether appellants have had a fair opportunity to react to the thrust of the rejection").

The Examiner states that showing is insufficient because the evidence is not "demonstrative evidence." Demonstrative evidence is evidence addressed directly to the senses without intervention of witnesses or testimony, as by actual sight, hearing, or taste. It is not evidence which demonstrates how the invention works as the Examiner appears to think. Appellant's evidence is demonstrative evidence. The Examiner hints at the correct reason by stating that a lab notebook page having the word "E-card" is not the kind of evidence that would enable one skilled in the art to understand the invention. However, this does not inform Appellant of the real deficiency in the evidence.

The Examiner also states that the invention was not completely disclosed at the meetings noted in the evidence. This

is an unsupported conclusion. We have no way of knowing from the evidence exactly what was conveyed at the meetings.

The real reason the evidence does not establish conception is because it does not show that Appellant was in possession of the claimed invention. The showing of conception must be commensurate in scope with the claims. All independent claims 1, 15, 16, 19, 21, and 38 contain the following limitation: "each ETC . . . having an electronic format that supports card scarcity and card authenticity." "Card scarcity" can be generated by user skill, timing, copy protection, limited manufacturing, and random distribution of partial sets (specification, pages 11-12, 15). "Card authenticity" can be accomplished with encryption; e.g., "Counterfeit ETCs can be detected using public-key/private-key encryption" (specification, page 12, lines 12-13). We do not find the concepts of "card scarcity" and "card authenticity" discussed anywhere in the evidence submitted. One of the slides is entitled "E-Card Security"; however, this appears to just refer to how the ETCs are accessed and there is no mention of card scarcity or card authenticity. This is just one example, but it applies to all claims. As another example, we do not find support for the limitations of entering a multiroom virtual environment and completing a set as recited in claim 16. The declarations should particularly point out how each claim limitation is supported by the evidence. Appellant has not

Appeal No. 1998-2848
Application 08/398,862

established conception of the claimed invention and the Rule 131 declarations are insufficient to overcome Smith. The anticipation rejection of claims 1-39 is sustained.

In addition, even assuming the evidence was sufficient to establish conception, Appellant has failed to establish diligence from a date prior to Smith's filing date to the constructive reduction to practice which occurred on the filing date of Appellant's application. We do not understand what the Examiner's comments have to do with diligence. Diligence is whether Appellant and his attorney worked without delay to get the application filed, not the contents of the document and the authenticity. While we agree with counsel's statement that, in many circumstances, "[i]t is not unreasonable to expect the preparation of a patent application to take the interval from December 2, 1994 until March 6, 1995" (Br18), since the delay is over three months, a declaration of counsel would normally be expected setting forth dates establishing progress towards filing. Therefore, Appellant has not established diligence from a date prior to Smith's filing data to the application filing date and the Rule 131 declaration is insufficient to overcome Smith. The anticipation rejection of claims 1-39 is sustained for this additional reason.

Appeal No. 1998-2848
Application 08/398,862

CONCLUSION

The rejection of claims 1-14 under 35 U.S.C. § 101 is sustained and the rejection of claims 15-20, 38, and 39 under § 101 is reversed. The rejection of claims 21-37 under § 101 is reversed because claim 21 is too indefinite to evaluate statutory subject matter. A new ground of rejection has been entered as to claims 21-37 under 35 U.S.C. § 112, second paragraph.

The rejection of claims 1-39 under 35 U.S.C. § 102(e) over Smith is sustained, but is denominated as a new ground of rejection because of new reasoning.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

Appeal No. 1998-2848
Application 08/398,862

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED - 37 CFR § 1.196(b)

Lee E. Barrett

LEE E. BARRETT
Administrative Patent Judge

Michael R. Fleming

MICHAEL R. FLEMING
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

5/10/12

JEFFREY V. NASE
Administrative Patent Judge